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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/400,724 09/21/99 OGRAM

M 1475B.5A

EXAMINER

TM02/0725

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ART UNIT PAPER NUMBER2161  
DATE MAILED:

07/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.****Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/400,724	OGRAM, MARK E.
	Examiner Edward R. Cosimano	Art Unit 2161

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 September 1999.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.
2. The disclosure is objected to because of the following informalities:

A) applicant must update:

- (1) the continuing data on page 1;

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) the following errors have been noted in the specification:

- (1) applicant's use of web address in:

(a) the paragraph at page 6, lines 9-12; and

(b) the paragraph at page 6, lines 13-16;

is improper, since:

(a) in electronic versions of the patent grant this address would create an improper hyper link to the specified address; and

(b) the content of the specified web address may change over time and, hence, would add new matter and/or alter the content/teachings of the instant disclosure over time.

Hence, applicant should delete the http:// from page 6, lines 12 & 16.

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)) & § 1.121(a)(1)-1.121(a)(6).

4. Claims 1-10 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 5,963,917 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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4.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) in regard to claims 1-10 of the instant application and claims 1-7 of U. S.

Patent No. 5,963,917 which commonly claim:

- (1) a computer network;
- (2) a phone network;
- (3) a merchant computer, which perform the same functions in either the patent or application;
- (4) a customer computer, which perform the same functions in either the patent or application;
- (5) a bank computer; and
- (6) a financial computer, which perform the same functions in either the patent or application.

4.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4.3. Claims 1-10 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-15 of copending Application No. 09/657,277. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

4.4 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A) in regard to claims 1-10 of the instant application and claims 1-15 of copending application 09/657,277 which commonly claim:

- (1) a computer network;
- (2) a phone network;

(3) a merchant computer, which perform the same functions in either application;

(4) a customer computer, which perform the same functions in either application;

(5) a bank computer; and

(6) a financial computer, which perform the same functions in either application.

4.5 Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4.6 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4.7 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

4.8 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Payne et al (5,715,314 or 5,909,492) or Sirbu et al (5,809,144) in view of an obvious equivalent variation.

5.1.1 In regard to claim 6, either Stuck or Payne et al ('314 or '492) or Sirbu et al ('144) disclose a remote purchasing system in which a customer electronically access a remote merchant, receives promotional data from the merchant and orders merchandise from the merchant over a network. Payment for the ordered merchandise is made electronically over the network using a remote payment/settlement system. The remote settlement system provides an indication of the complete payment transaction to the merchant before the ordered merchandise is sent to the customer.

5.1.2 Neither Stuck nor Payne et al ('314 nor '492) nor Sirbu et al ('144) disclose the use of a telephone network to communicate the customer account and price information to a remote bank computer. However, since either Stuck or Payne et al ('314 or '492) or Sirbu et al ('144) disclose the use of a communications network to transmit information between the various computers that make up the e-commerce systems of either Stuck or Payne et al ('314 or '492) or Sirbu et al ('144) and a telephone network is a communications network, it would have been obvious to one of ordinary skill at the time the invention was made that any suitable communications network, for example a telephone network could be used in the e-commerce

systems of either Stuck or Payne et al ('314 or '492) or Sirbu et al ('144) to transmit information between the various computer systems that cooperate to form the e-commerce systems of either Stuck or Payne et al ('314 or '492) or Sirbu et al ('144).

6. The following is an Examiner's Statement of Reasons for Allowance of the instant claims over the prior art of record:

A) the prior art, for example, either Stuck or Payne et al (5,715,314 or 5,909,492) or Sirbu et al (5,809,144) or Fujioka (JP 11-053444) or the BusinessWorld article or Rowney et al (5,987,140) disclose a remote purchasing system in which a customer electronically access a remote merchant, receives promotional data from the merchant and orders merchandise from the merchant over a network. Payment for the ordered merchandise is made electronically over the network using a remote payment/settlement system. The remote settlement system provides an indication of the complete payment transaction to the merchant before the ordered merchandise is sent to the customer.

B) however in regard to claim 1, the prior art does not teach or suggest a E-commerce system in which:

(1) a merchant computer that transmits promotional data to a remote customer computer over a computer network and in response to an order from the second computer transmits cost/price information over the computer network to a payment/settlement computer.

(2) a customer computer that receives the promotional data sent from the merchant computer over a computer network and in response to an order from the customer transmits customer account information over the computer network to the payment/settlement computer.

(3) a bank computer that receives cost/price information and customer account information sent from the payment/settlement computer over a telephone network and returns an indication of the authorization of the requested payment to the payment/settlement computer over the telephone network.

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(4) a payment/settlement computer that receives the cost/price information sent from the merchant computer over the computer network and receives the customer account information sent from the customer computer over the computer network and transmits the received cost/price information and customer account information to the bank computer over a telephone network. Further the payment/settlement computer receives an indication of the authorization of the requested payment from the bank computer over the telephone network and relays the indication of the authorization of payment to the merchant computer over the computer network.

Claims 2-5 are allowable for the same reason.

B) however in regard to claim 7, the prior art does not teach or suggest a E-commerce system in which:

(1) a merchant computer that transmits promotional data to a remote computer over a computer network and in response to an order from the remote computer transmits cost/price information over the computer network to a payment/settlement computer.

(2) a payment/settlement, computer that receives the cost/price information customer account information over the computer network and transmits the received cost/price information and customer account information over a telephone network to an authorization computer. Further the second computer receives an indication of the authorization of the requested payment from the authorization computer over the telephone network and relays the indication of the authorization of payment to the merchant computer over the computer network.

Claims 8-10 are allowable for the same reason.

7. The commonly cited prior art in the parent applications Serial No. 08/597,017 filed February 05,1996 and Serial No. 09/166,749 filed October 05,1998 has been considered by the examiner.

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8. In regard to the Information Disclosure statement filed December 17, 1999, the references which have not been considered by the examiner, have not been considered because applicant failed to provide either:

A) a concise statement of the relevancy of each cited document as 37 CFR § 1.98(a)(3);

or

B) a properly completed PTO-1449 listing each cited document as 37 CFR § 1.98(a)(1).

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10.1 The fax phone number for UNOFFICIAL FAXES or for OFFICIAL FAXES for this group is either (703) 308-6165 or (703) 308-6296 or (703) 308-6306 or (703) 308-6606 or (703) 308-9051 or (703) 308-9052.

07/19/01

  
Edward R. Cosimano  
Primary Examiner A.U. 2161